

# **Notice of Allowability**

**Application No.**

09/971,020

**Examiner**

Ashwin Mehta

**Applicant(s)**

SANO ET AL.

**Art Unit**

1638

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed 19 November 2003.
2. ☒ The allowed claim(s) is/are 35-46 and 49-53.
3. ☒ The drawings filed on 19 November 2003 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## **Attachment(s)**

- |  |  |
|--|--|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                     |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>attached</u> . |
| 3 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. <u>11/192,003</u> | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                             |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material                       | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance                       |
|  | 9 <input type="checkbox"/> Other   |

***Drawings***

1. Receipt of formal drawings for Figures 1-6 is acknowledged.

***Specification***

2. Receipt is acknowledged of the substitute sequence listing, in paper and computer-readable forms, which includes SEQ ID NOs: 1-22.

***Claim Objections and Rejections***

3. The objection to claim 33 is withdrawn in light of its cancellation.
4. The rejections of claims 19, 21-27, 32, under 35 U.S.C. 112, 1<sup>st</sup> paragraph, are withdrawn in light of their cancellation.

***Examiner's Amendment***

5. An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on December 15, 2003, Erin Dunston requested an extension of time for 1 MONTH(S) and authorized the Director to charge Deposit Account No. 02-4800 the required fee of \$530 for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

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The application has been amended as follows:

In claims 42 and 43, line 2, after “sequence”, the recitation, --in antisense orientation-- was inserted.

44. (Currently amended) A method for decreasing theobromine synthesis in a plant, said method comprising introducing into a plant cell double-stranded RNA wherein one strand of said double-stranded RNA encodes a polypeptide encoded by [comprising] a nucleotide sequence according to any one of Claims 35-38, wherein said double-stranded RNA inhibits expression of theobromine synthase, resulting in a decrease of theobromine synthesis from 7-methylxanthine.

In claim 45, line 1, the term, “transformed” was deleted.

Claims 47 and 48 were cancelled.

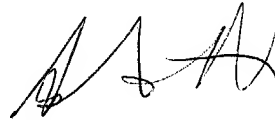
49. (Currently amended) A method for decreasing theobromine synthesis in a plant, said method comprising introducing into a plant cell [two or more copies of] the nucleotide sequence according to any one of Claims 35-38, wherein transcription [expression] of said nucleotide sequence causes a decrease in the expression of theobromine synthase due to co-suppression, resulting in a decrease of theobromine synthesis from 7-methylxanthine [is co-suppressed].

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***Contact Information***

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

December 16, 2003



Ashwin D. Mehta, Ph.D.  
Primary Examiner  
Art Unit 1638